REMARKS

In the Office Action dated July 23, 2007, claims 11-40 were presented for examination. Claims 11, 12, 17-20, 24-27, 31-38, and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Black et al.*, U.S. Patent No. 5, 878,056 (hereinafter *Black*), in view of *Tang*, "Storage Area Networking: The Network Behind the Server." Claims 13-16, 21-23, 28-30, and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Black et al.*, U.S. Patent No. 5, 878,056, in view of *Tang*, "Storage Area Networking: The Network Behind the Server," and in further view of *AAPA* (Applicant's Admitted Prior Art).

The following remarks are provided in support of the pending claims and responsive to the Office Action of July 23, 2007 for the pending application.

I.   Rejection of Claims 11, 12, 17-20, 24-27, 31-38, and 40 under 35 U.S.C. §103(a)

In the Official Action of July 23, 2007, the Examiner rejected claims 11, 12, 17-20, 24-27, 31-38, and 40 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,878,056 to *Black et al.* (hereinafter *Black*) in view of *Tang*.

Applicant's remarks pertaining to *Black* in the prior Office Action response are hereby incorporated by reference.

As noted by the Examiner, *Black* "does not explicitly disclose a computer system comprising a storage area network."[1] The Examiner combines *Black* with *Tang* since *Tang* teaches a storage area network (SAN). However, *Tang* does not teach a SAN <u>controller</u> to control a message queue. The Examiner does not state in the Office Action that *Tang* teaches a SAN controller. Rather, the Examiner states that *Tang* is employed to teach a SAN, not the properties or configuration of the SAN controller. Accordingly, it is clear that the Examiner has

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[1] See Office Action page 3.

merely cited a prior art reference that discusses a SAN and has omitted the term SAN controller from the analysis in the Office Action.

In contrast to both *Black* and *Tang*, Applicant is claiming that the control function of the transactional management of messages and associated queues is removed from the individual server, and is claiming management thereof by a SAN controller. The control and management of messages at the network level eliminates issues associated with server failure and any messages stored thereon. It is the SAN controller that is employed by Applicants to manage a message queue. There is no teaching in either *Black* or *Tang* to employ a SAN controller to manage a message queue.

To establish a rejection under 35 U.S.C. §103(a), all the claim limitations must be taught or suggested in the prior art.[2] If the prior are references do not teach or suggest every claim limitation of the Applicant's invention, then they do not meet every requirement under 35 U.S.C. §103(a) and are not sufficient to uphold a rejection under 35 U.S.C. §103(a).[3] In the present case, as stated above, the major difference between Applicant's invention and the combination of *Black* and *Tang*, is that Applicant is utilizing the controller of a SAN to perform the function of storage and management of messages in place of individual servers and to place such responsibility at the network level. Therefore, because *Black* does not teach or suggest utilizing a SAN and *Tang* does not teach utilizing a SAN controller for management of messages and messaging techniques in the network, these prior art references do not teach every element of Applicant's claimed invention. Accordingly, the *Black* and *Tang* patents, when combined are not sufficient to uphold a rejection under 35 U.S.C. §103(a).

It is clear that the Examiner is combining the message passing techniques of *Black* with the SAN of *Tang*. However, even such a combination does not teach the elements of the

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[2] MPEP §2143.03 (Citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

[3] See MPEP §2143.

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message passaging techniques of Applicant. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, since the combination of references comes short of teaching each of the elements claimed by Applicant. It is respectfully suggested that the Examiner's rejection under 35 U.S.C. §103(a) which does not contain teachings of the pending claims is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of *Black et al.* with *Tang* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests that the Examiner remove the rejection and direct allowance of claims 11, 12, 17-20, 24-27, 31-38, and 40.

II.   Rejection of Claims 13-16, 21-23, 28-30 and 39 under 35 U.S.C. §103(a)

In the Official Action of July 23, 2007, the Examiner rejected claims 13-16, 21-23, 28-30, and 39 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,878,056 to *Black et al.* (hereinafter *Black*) in view of *Tang*, and further in view of Applicant's Admitted Prior Art (herein after *AAPA*).

Applicant's remarks pertaining to *Black* and *Tang* in both the prior Office Action response and above in this response are hereby incorporated by reference.

As noted above by Applicant, *Black* does not teach or discuss employment of a SAN or a SAN controller. In this same manner, *Tang* does not teach or discuss a SAN controller. Although *AAPA* discusses employment of a "connection handle" associated with an asynchronous message and queuing system, *AAPA* fails to teach such a limitation with respect to a SAN in general or to a SAN controller in specific. Each of the claims in this rejection are dependent claims from an independent claim that includes a SAN controller in association with messaging. There is no teaching in *Black*, *Tang*, or *AAPA* for a SAN controller to manage a message queue. *AAPA* discusses a connection handle associated with messaging, but not in relation to a SAN controller. It would not be obvious to combine the prior art teachings of *Black*, *Tang*, and *AAPA* since combined these three prior art references fail to teach all of the element

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claimed by Applicant. To establish a rejection under 35 U.S.C. §103(a), all the claim limitations must be taught or suggested in the prior art.[4] If the prior are references do not teach or suggest every claim limitation of the Applicant's invention, then they do not meet every requirement under 35 U.S.C. §103(a) and are not sufficient to uphold a rejection under 35 U.S.C. §103(a).[5] The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, since the combination of references comes short of teaching each of the elements claimed by Applicant.

III. Rejections Under 35 U.S.C. §103(a)

Furthermore, there is no motivation to combine the references in the manner set forth by the Examiner. *Black* does not teach applying the messaging technique with a SAN, and more specifically with a SAN controller. It is Applicant's position that *Black* does not pertain to the claimed subject matter and therefore is not analogous art. "The analogous art test requires that the Board show that a reference is either in the field of the applicant's endeavour or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection."[6] It is Applicant's position that *Black* is not a proper reference for application under 35 U.S.C. §103(a) as one of ordinary skill in the art would not have reasonably expected to look for a solution in *Black* to the problem faced by the Applicant as even the

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[4] MPEP §2143.03 (Citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

[5] See MPEP §2143.

[6] *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cor. 1992). See also *In re Clay*, stating:

> If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his rejection. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

In re Clay, 966 F.2d 656, 659-660 (Fed. Cir. 1992).

Examiner has admitted *Black* does not pertain to a computer system that employs a SAN. Accordingly, it is Applicant's position that *Black* is not a proper reference for application under 35 U.S.C. §103(a) as one of ordinary skill in the art would not have reasonably expected to look for a solution in *Black* to the problem faced by the invention.

Even if one were to consider *Black* as analogous art, in order to combine prior art references under 35 U.S.C. §103(a), the prior art references must have a suggestion or motivation to modify the references or combine the teachings.[7] "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure." [8] It is Applicant's position that there is no motivation in the prior art references for combining *Black* and *Tang*. Rather, the motivation for such a combinations stems from the language in Applicant's claims.

As noted above, *Black* applies to a messaging technique in a computer system that does not employ a SAN. There is no teaching, suggestion, or motivation in *Black* to utilize a SAN and/or SAN controller in their messaging technique. In a similar manner, *AAPA* does not teach or discuss use of a SAN and/or SAN controller in relation to messaging techniques. It is well settled that the mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. The Examiner is not permitted to use Applicant's claimed invention as a template for piecing together the omitted elements without a suggestion for such a combination. There is no suggestion in either *Black* or *AAPA* to employ a SAN and/or SAN controller. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight."[9] Most patents may be considered combination patents in which different elements are combined from prior art

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[7] See MPEP §2143.

[8] MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

[9]*In re Dembiczak*, 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999).

to achieve a new and useful apparatus and/or method. Although Applicant's invention may appear to combine elements found in different prior art disclosures, the motivation to combine the references must be in the prior art not in Applicant's pending claims. There is no motivation in the prior art to combine the references, since such a combination would go against the teachings of *Black*, and *Tang*, and/or *AAPA*.

Applicant disputes that *Black*, *Tang*, and/or *AAPA* provides motivation to employ a SAN controller in the manner claimed by Applicant. There is no teaching or suggestion in *Black* to modify the invention for applying the SAN controller to a messaging technique. To modify the teaching of *Black* for applying a SAN controller to a messaging technique as claimed by Applicant, would go against the teaching of *Black* or would modify *Black* in a way not contemplated by *Black*.

It is well settled that each statement of obviousness for the purpose of combining each of the numerous references of record must be found and suggested in the references themselves and not only in the fertile mind of the Examiner. The conclusive statements of the Examiner must be based upon specific evidence, suggestions and findings in the references of record relied upon by the Examiner in the rejection of the claimed subject matter. It is respectfully submitted that the record before the Examiner provides the element of a messaging technique as the sole reason to combine the references. However, there is no teaching or suggestion in *Black*, *Tang*, or *AAPA* about employing a SAN controller to manage messaging at the network level. The Examiner has not established a prima facie case of obviousness with respect to the aforesaid set of claims, there being no motivation to combine the references. "The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."[10] It is respectfully suggested that the Examiner's rejections under 35 U.S.C. §103(a) is without merit and must be withdrawn. Accordingly, Applicant respectfully contends that the combination of

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[10] *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Black, *Tang*, and/or *AAPA* does not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a).

Even if one were to accept that *Black, Tang*, and/or *AAPA* when combined teach all of the elements of claims 11-40 there must still be a reasonable basis found in the prior art to apply such a combination. There is no teaching, suggestion, or motivation in *Black* to employ a SAN controller in relation to a messaging technique. As for the secondary reference of *Tang*, there is no support for a SAN controller, and more specifically, for a SAN controller to be used for a messaging technique. The key assumption is that the secondary reference, *i.e. Tang*, teaches that a SAN controller, could be substituted into the messaging technique employed by the primary reference, *Black*.

The Examiner however, has provided no findings of fact in support of his position that the SAN of *Tang* would have been desired by the primary reference of *Black*. There is no motivation in *Black* to substitute a SAN controller into a messaging tool in a computer system. Thus, the rejections as stated in the record fails to supply the requisite motivation to combine the references as required under 35 U.S.C. §103(a). Accordingly, Applicant respectfully contends that the teachings of the combined references of record do not meet the standard set by the CAFC's interpretation of 35 U.S.C. §103(a), and respectfully requests reconsideration of the rejection of, and respectfully requests allowance of claims 11-40.

IV.   Conclusion

Based upon the above remarks, Applicant respectfully requests consideration of the claims. It is submitted that all of the claims in the application are in condition for allowance and such action is respectfully requested. Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful in resolving any remaining issues pertaining to this application, the undersigned respectfully requests that she be contacted at the number indicated below.

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For the reasons outlined above, an allowance of this application is respectfully requested.

Respectfully submitted,

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